The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 38

## **MAILED**

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 1 9 2002

PAT. & T.M. OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEETHARAMAIAH MANNAVA, JAMES E. RHODA, HERBERT HALILA, LARRY G. JACOBS, and EDWARD A. RAINOUS

Application No. 08/719,341

ON REMAND

Before COHEN, ABRAMS, and FRANKFORT, <u>Administrative Patent Judges</u>.

COHEN, <u>Administrative Patent Judge</u>.

## REMAND

The present application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the issue discussed below.

In reviewing the rejection dated February 22, 1999 (Paper No. 32) and the examiner's answer (Paper No. 36), we find that

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the examiner has rejected claims 1 through 20 under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. 5,531,570 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. It is particularly noteworthy that the examiner relies upon *In re Schneller*, 397 F.2d 350, 355, 158 USPQ 210, 215 (CCPA 1968) in the body of the rejection, as set forth on page 8 of the referenced rejection.

The Manual of Patent Examining Procedure (MPEP) § 804 (Eighth Edition, August 2001) states the following at 800-27:

The decision in In re Schneller did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. court in Schneller cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." Schneller, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on Schneller will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on Schneller. If an examiner determines that a double patenting rejection based on Schneller is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

This panel of the Board remands this application to the examiner to permit reconsideration of this rejection consistent

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with the guidance provided in the foregoing quotation from MPEP § 804, regarding the propriety of the rejection based upon *Schneller*, and to obtain the approval of the TC Director if the examiner and the SPE desire to maintain this rejection.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, August 2001).

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, e.g., the 35 U.S.C. § 103(a) rejections, the application should be promptly returned to the Board of Patent Appeals and Interferences.

## REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E ADDAMS

NEAL E. ABRAMS Administrative Patent Judge BOARD OF PATENT APPEALS AND INTERFERENCES

Charles E. Frankford

Administrative Patent Judge

ICC:psb

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